

HAMILTON
BROOK
SMITH &
REYNOLDS, P.C.

PATENTS, TRADEMARKS
COPYRIGHTS & LITIGATION

530 VIRGINIA ROAD
P.O. BOX 9133
CONCORD, MA 01742-9133
TEL (978) 341-0036
FAX (978) 341-0136
www.hbsr.com

MUNROE H. HAMILTON
(1906-1984)

DAVID E. BROOK
JAMES M. SMITH
LEO R. REYNOLDS
JOHN L. DUPRE
DAVID J. BRODY
MARY LOU WAKIMURA
ALICE O. CARROLL
N. SCOTT PIERCE
HELEN E. WENDLER
CAROLYN S. ELMORE
SUSAN G. L. GLOVSKY
DOREEN M. HOGLE
RICHARD W. WAGNER
ROBERT T. CONWAY
RODNEY D. JOHNSON
DAVID J. THIBODEAU, JR.
ANNE J. COLLINS
LISA M. TREANNIE
TIMOTHY J. MEAGHER

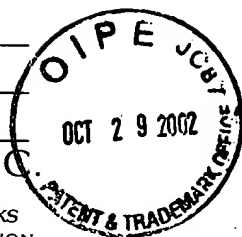
GERALD M. BLUHM
JOHN M. CARD
KELLIE L. CARDEN
LINDA M. CHINN
STEVEN G. DAVIS
THERESA A. DEVLIN
COLIN C. DURHAM
CAROL A. EGNER
ERIK L. ENCE
CAROLINE M. FLEMING
TODD A. GERETY
ANTOINETTE G. GIUGLIANO
JONG P. HONG
PAUL P. KRIZ
C. STEVEN KURLOWECZ
HELEN LEE
CHRISTOPHER J. LUTZ
JOSEPH M. MARAIA
DEIRDRE E. SANDERS
KEVIN T. SHAUGHNESSY
MARK B. SOLOMON
J. SCOTT SOUTHWORTH
A. CRISTINA TAYLOR*
JON C. TRACHTENBERG
DARRELL L. WONG
JOSEPH C. ZUCCHERO
* NOT ADMITTED IN MASS.

OF COUNSEL
RICHARD A. WISE
ANNE I. CRAIG
ELIZABETH W. MATA
EUGENE BERMAN*
* NOT ADMITTED IN MASS.

PATENT AGENTS
SUSAN M. ABELLEIRA
SANDRA A. BROCKMAN
MARY K. MURRAY
PAMELA A. TORPEY
KAREN J. TOWNSEND
ROBERT H. UNDERWOOD

TECHNOLOGY SPECIALISTS
ALEXANDER AKHIEZER
PAUL G. ALLOWAY
KRAIG ANDERSON
JESSE A. PECKER
GIOVANNA PESSENDEN
NICHOLAS J. SISTI
TROY T. SVIHL
VIVIAN J. TANNOCH
MICHAEL M. YAMAUCHI

MICHAEL KEWESHAN
ADMINISTRATIVE DIRECTOR
BARBARA J. FORGUE
ADMINISTRATOR OF
PATENT AND
TRADEMARK PRACTICE



CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as First Class Mail in an envelope addressed to Assistant Commissioner for Patents, P.O. Box 2327, Arlington, VA 22202

on 10/25/02 Ellen T. Spear
Date Signature

Ellen T. Spear
Typed or printed name of person signing certificate

October 25, 2002

RECEIVED

OCT 30 2002

Technology Center 2100

Box AF
Assistant Commissioner for Patents
P.O. Box 2327
Arlington, VA 22202

Re: Appellant(s): Mustansir Banatwala and Jorge Camargo
Application No.: 08/781,696 Filed: January 10, 1997
Confirmation No.: 8573
Title: COMPUTER METHOD AND APPARATUS FOR
PREVIEWING FILES OUTSIDE OF AN APPLICATION
PROGRAM
Docket No.: 2731.1002-000

Sir:

Transmitted herewith are three (3) originally signed copies of a Brief on Appeal for filing in the subject application. The Brief on Appeal is filed pursuant to the Notice of Appeal received by the U.S. Patent and Trademark Office on August 27, 2002.

1. ☐ Appellant hereby petitions to extend the time for filing a Brief on Appeal for month(s) from to .
 2. ☐ A ☐ month extension of time to extend the time for filing a Brief on Appeal from to was filed on with payment of a \$ fee.
- ☐ Appellant hereby petitions for an additional month extension of time for filing a Brief on Appeal from to .

3. ☐ A Request for Oral Hearing before the Board of Patent Appeals and Interferences is being filed concurrently herewith.

4. Fees are submitted for the following:

<input type="checkbox"/>	Extension of Time for [] month(s)	\$	_____
<input type="checkbox"/>	Additional Extension of Time:		
	Fee for Extension ([] mo.)	\$	_____
	Less fee paid ([] mo.)	- \$	_____
	Balance of fee due	\$	0
<input checked="" type="checkbox"/>	Brief on Appeal	\$	320
<input type="checkbox"/>	Other _____	\$	_____
	TOTAL	\$	320

5. The method of payment for the total fees is as follows:

☒ A check in the amount of \$320 is enclosed.

☐ Please charge Deposit Account No. 08-0380 in the amount of \$[].

Please charge any deficiency or credit any overpayment in the fees that may be due in this matter to Deposit Account No. 08-0380. A copy of this letter is enclosed for accounting purposes.

Respectfully submitted,

HAMILTON, BROOK, SMITH & REYNOLDS, P.C.

By C. Steven Kurlowecz

C. Steven Kurlowecz

Registration No.: 46,846

Telephone: (978) 341-0036

Facsimile: (978) 341-0136

Concord, MA 01742-9133

Dated: 10/25/2



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

SC
#25
11-5-02

Appellants: Mustansir Banatwala and Jorge Camargo
Application No.: 08/781,696 Group Art Unit: 2176
Filed: January 10, 1997 Examiner: Cesar B. Paula
For: COMPUTER METHOD AND APPARATUS FOR PREVIEWING FILES
OUTSIDE OF AN APPLICATION PROGRAM

CERTIFICATE OF MAILING	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as First Class Mail in an envelope addressed to Assistant Commissioner for Patents, P.O. Box 2327, Arlington, VA 22202	
on <u>10/25/02</u>	<u>Ellen T. Spear</u>
Date	Signature
<u>Ellen T. Spear</u>	
Typed or printed name of person signing certificate	

BRIEF ON APPEAL

Box AF
Assistant Commissioner for Patents
P.O. Box 2327
Arlington, VA 22202

RECEIVED
OCT 30 2002
Technology Center 2100

Sir:

This Brief on Appeal is submitted pursuant to the Notice of Appeal received in the U.S. Patent and Trademark Office on August 27, 2002, and in support of the appeal from the final rejection(s) set forth in the Office Action mailed on April 22, 2002. The fee for filing a brief in support of an appeal is enclosed.

I. REAL PARTY IN INTEREST

The real party in interest is Eastman Kodak Company, Rochester, New York 14650-2201 and at least eiStream, Inc., Dallas, Texas 75219, IBM Corporation, White Plains, New York 10604 and Microsoft Corporation, Redmond, Washington 98052, licensees of the subject matter described in the subject application. Eastman Kodak Company is the Assignee of the entire right, title and interest in the subject application, by virtue of an Assignment from Kodak Limited

recorded on January 30, 2001 at Reel 011547, Frames 0512-0517. Kodak Limited was the Assignee of the entire right, title and interest in the subject application, by virtue of an Assignment from Wang Laboratories, Inc. recorded on April 10, 1997 at Reel 8451, Frames 0407-0409. Wang Laboratories, Inc. was the Assignee of the entire right, title and interest in the subject application, by virtue of an Assignment from the inventors, Mustansir Banatwala and Jorge Camargo, recorded on January 10, 1997 at Reel 8394, Frames 0065-0068.

II. RELATED APPEALS AND INTERFERENCES

Appellants, the undersigned Attorney and Assignee are not aware of any related appeals or interferences which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

III. STATUS OF CLAIMS

Claims 1 through 17 are pending and have been finally rejected, and a copy of the claims as last amended appears in the Appendix of this Brief.

Claims 1, 5-7, 10, 12-13 and 15-17 were amended in the Amendment filed on July 14, 1999.

Claims 1, 7 and 12 were amended in the Amendment After Final Rejection filed on December 20, 1999.

Claims 1, 7, 12 and 16 were amended in the Amendment filed on June 6, 2000.

Claims 1, 5-7, 12-13 and 16-17 were amended in the Amendment After Final Rejection filed on October 31, 2000.

Claims 1, 7 and 12 were amended in the Amendment filed on January 16, 2002.

Claims 2-4, 8-9, 11 and 14 appear as originally filed.

IV. STATUS OF AMENDMENTS

All amendments, as listed, have been entered. No amendment has been filed subsequent to the final rejection dated April 22, 2002.

V. SUMMARY OF INVENTION

The present invention is directed to a computer system and method for previewing internal file characteristics and images of a computer file through an extension coupled to an operating system. The extension is entirely integrated and shares a common user interface with the operating system. Moreover, the extension obviates the need to open an application program to preview the file. Previewing with respect to a file includes an overview, or summary, of file characteristics and contents, including images, as stated in the Specification as originally filed on page 2, lines 20-22. Specifically, the preview includes displaying indicia of internal file characteristics and displaying a file image separate from the display of indicia of internal file characteristics. In the shared user interface of the operating system invention extension, user selection of a desired file results in the extension opening the selected file in a manner free of opening an application program and in a manner free of decoding any indicia of internal file characteristics from a filename of the selected file. In this way, internal file characteristics (i.e., those obtainable by opening and reading the file), as opposed to external file characteristics (i.e., those obtainable by decoding a filename or reading a file allocation table) are displayed as part of the preview. A display assembly, displays the indicia of internal file characteristics separate from the file image such that a preview of the user-selected file is provided.

The combination of 1) an extension coupled to an operating system operating in a manner free of opening an application program, the extension sharing a common user interface with the operating system, 2) displaying indicia of internal file characteristics and 3) displaying a file image separate from the display of indicia of internal file characteristics renders the present invention patentably distinct and nonobvious over the cited prior art.

VI. ISSUES

Whether Claims 1-17 are properly rejected under 35 U.S.C. § 103(a) as being obvious over Windows NT Explorer 4.0 screen dumps Figs. 1-9, 1994 (hereinafter "Explorer") in view of Photoimpact 3.0 file dialog box screen dumps 1996 (hereinafter "Photoimpact").

VII. GROUPING OF CLAIMS

The group of Claims 1-17 does not stand or fall together. Claims 1, 7, and 12 are independent claims that stand or fall separately. Dependent Claims 2 stands with Claim 1, but falls separately. Dependent Claims 16-17 stand with Claim 12, but fall separately.

Dependent Claims 3, 8 and 13 are similar and stand or fall based on respective base Claims 1, 7 and 12.

Dependent Claims 4, 9 and 14 are similar and stand or fall based on respective base Claims 1, 7 and 12.

Dependent Claims 5, 10 and 15 are similar and stand or fall based on respective base Claims 1, 7 and 12.

Dependent Claims 6 and 11 are similar and stand or fall based on respective base Claims 1 and 7.

VIII. ARGUMENT

Claims 1-17 have been rejected under 35 U.S.C. § 103(a) as being obvious over Windows NT Explorer 4.0 screen dumps Figs. 1-9, 1994 (hereinafter "Explorer") in view of Photoimpact 3.0 file dialog box screen dumps 1996 (hereinafter "Photoimpact").

In support of this rejection, the Examiner states that "[i]t would have been obvious to a person of ordinary skill in the art at the time of the invention to combine the teachings of Windows NT Explorer, and Photoimpact, because Windows NT Explorer teaches above the flexibility of file management features, moving, copying, the display of detailed file characteristics without the time-consuming task of opening an application program in working memory, etc not afforded in most application programs." (Final Office Action dated April 22, 2002).

The Examiner states further that "Windows NT Explorer discloses an extension...the extension sharing a user interface with the operating system...enabling display of internal file characteristics and the file image of the desired file by opening the desired file in a manner free of opening an application program in working memory...(Quick View pop-up window in Fig.2, and pop-up window in fig. 6-7, which shares an interface with windows os, enables user to open, and display the internal contents of a file, e.g., color type, graphics, font etc, and the file image

without opening an application program in the computer's memory)." and that "Photoimpact teaches the display of file characteristics – color type, compression, image dimensions, number of pixels, etc. – separate from the image (p. 1 - 2)." (Final Office Action dated April 22, 2002).

To establish a *prima facie* case of obviousness 35 U.S.C. § 103(a), three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success with the modified or combined references. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991), (MPEP 2143).

There is no suggestion to combine the Explorer and Photoimpact references.

The cited prior art references (Explorer and Photoimpact) lack a suggestion to combine the references. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990) (MPEP 2143.01).

The cited user interface screen dumps of Explorer and Photoimpact do not even recognize the difference between an operating system extension and an application program. Without addressing this distinction the cited references can provide no suggestion to combine Explorer and Photoimpact. The Explorer and Photoimpact references do not disclose or teach any mechanism for interfacing Explorer or Photoimpact with any another computer program. Examples of mechanisms that could be used to interface computer programs include application program interfaces ("API") and software development kits ("SDK"). Neither cited reference makes any mention of possible ways in which to combine, or modify, computer programs.

The Examiner disagrees with the Appellants' arguments that neither Windows NT Explorer nor Photoimpact 3.0 teach the difference between an OS extension and an application program. The Examiner states in the Response To Arguments section of the Final Office Action dated April 22, 2002 that "...as can be seen in Fig. 7 Windows NT teaches an extension for

displaying the details or indication of file characteristics – compression, and type of compression used in forming the file (i.e., “zip” etc), color type (i.e., bitmap, black & white or color).

Photoimpact is an application program for processing images, and which is not affiliated with the operating system (Examiner emphasis added). Photoimpact displays file characteristics – color type, compression, image dimensions, number of pixels, etc. – separate from the image (p. 1-2).”

The Examiner suggests that the combination of Explorer and Photoimpact is desirable, but neither of these prior art references themselves suggests the desirability of the combination. Appellants note that the level of skill in the art cannot be relied upon to provide the suggestion to combine references. *Al-Site Corp. v. VSI Int’l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999) (MPEP 2143.01). The suggestion to combine must come from the references themselves. The Photoimpact reference does not suggest any modification in which Photoimpact runs as an extension to the operating system (operating system means) instead of an application program. Neither does Photoimpact suggest that its functionality (e.g., display of file images and internal file characteristics) could be combined with the Explorer extension in order to provide an extension for previewing file images and internal file characteristics that is entirely integrated with the operating system and shares a user interface with the operating system, as is claimed in the present invention.

The pertinent claim language of independent Claim 1 reads “an extension coupled to the operating system in a manner such that the extension is entirely integrated with the operating system, the extension sharing a user interface with the operating system...the extension enabling display of a recitation of indicia of internal file characteristics...by opening the desired file in a manner free of opening an application program in working memory”.

The pertinent claim language of independent Claim 7 reads “a file manager coupled to the operating system, including sharing a user interface with the operating system, the file manager...enabling display of indicia of internal file characteristics and file image of a user-selected file by opening the desired file...outside of an application program opened and running in the working memory”.

The pertinent claim language of independent Claim 12 reads “providing operating system means for enabling display of indicia of internal file characteristics...the operating system means sharing a user interface with other operating system means and enabling display of the internal

file characteristics and the file images outside of an application program opened and running in the working memory; and in a manner free of opening and running an application program in the working memory, and...displaying the indicia of internal file characteristics”.

Therefore, there is no suggestion in the prior art to combine the Explorer and Photoimpact references.

The combination of Explorer and Photoimpact lack a reasonable expectation of success.

Even if a motivation to combine the cited prior art references did exist, the combination of the Explorer and Photoimpact references lacks a reasonable expectation of success because neither of the cited prior art references address the inherent problems involved in converting an application program into an operating system extension. Application programs are loaded into working memory and also typically load object oriented programming controls (e.g., Microsoft OLE controls) to provide support for various user interface functionality. Loading and opening application programs is costly both in terms of memory used and time to perform the loading and opening operations.

The present invention recognizes the inherent limitations and distinctions between application programs and extensions coupled to operating systems. The present invention addresses these inherent limitations by teaching, among other features, a sharing of a user interface with the operating system, thus avoiding the costly load time and working memory required by utilizing an applications program's user interface. Independent Claims 1, 7 and 12 explicitly recite the limitation “sharing a user interface with the operating system”.

As presented above, the Examiner disagrees with the Appellants' arguments that neither Windows NT Explorer nor Photoimpact 3.0 teach the difference between an OS extension and an application program. The Examiner states in the Response To Arguments section of the Final Office Action dated April 22, 2002 that “...as can be seen in Fig. 7 Windows NT teaches an extension for displaying the details or indication of file characteristics – compression, and type of compression used in forming the file (i.e., “zip” etc), color type (i.e., bitmap, black & white or color). Photoimpact is an application program for processing images, and which is not affiliated with the operating system (Examiner emphasis added). Photoimpact displays file characteristics

– color type, compression, image dimensions, number of pixels, etc. – separate from the image (p. 1-2).”

Appellants question the use of screen dumps absent a corresponding text narration (such as cited Microsoft Explorer) as a proper teaching of the prior art for the purposes of citing the rejection under § 103. Such screen dumps provide an isolated illustration that is open to a variety of interpretations. Without a corresponding text narration or description, many of those interpretations are akin to taking a passage of a reference out of context. Further, the Examiner's interpretation of Explorer screen dumps is inconsistent with the whole thrust of the Explorer operating system features. From the teachings of the book “Inside the Windows NT File System” by Helen Custer, copyright 1994 by the Microsoft Corporation and published by Microsoft Press, Windows NT Explorer features are intended to be fast and use minimal resources. Windows NT Explorer achieves these goal by only displaying external file characteristics and not opening the file itself. Windows NT Explorer is not meant to be memory or processing intensive and therefore does not open an application program to provide file previewing features.

Seen in this fuller, more proper light, the cited Explorer screen dumps are less than enlightening and do not teach or suggest the operating system extensions (means) claimed by the present invention. In particular, the cited Explorer screen dumps do not imply or suggest display of internal file characteristics *outside of opening an application program* as contended by the Examiner. Photoimpact, being an application program, does not add to the cited Explorer screen dumps the displaying of internal file characteristics outside of an application program. Rather the combination of cited Explorer and Photoimpact teachings as a whole would suggest Windows NT Explorer calling (opening and running) Photoimpact to display internal file characteristics. For these reasons the combination of cited Explorer screen dumps and Photoimpact does not have a likelihood of success of producing the claimed present invention.

In particular, cited Fig. 7 is a screendump displaying an image of a dialogbox showing external file characteristics, whereas the claims are limited to internal file characteristics and the file image. The cited Fig. 7 does not address the inherent problems involved in converting an application program into an operating system extension. Cited Fig. 7 provides no text, diagrams or other teachings of how to convert an application program into an operating system extension,

or operating system means, or file manager, as is taught by the present invention and recited in the claims.

The Examiner further states in the Response To Arguments section of the Final Office Action dated April 22, 2002 that "...as seen in Fig. 2- 4 Windows NT teaches the integration of an application program which allows a user to open or look inside a file, and Windows Explorer." Figs 2 - 4 of the Windows NT Explorer screendumps disclose invoking (Fig. 2) the "Quick View" add-in/extension of Windows NT Explorer in order to display (Fig. 3) a file image and that the "Quick View" add-in/extension is jointly owned/produced (Fig. 4) by Microsoft Corp. and Outside In View Technology. "Quick View" is an add-in/extension to Windows NT Explorer, not an application program as the Examiner contends. "Quick View" does not run as a stand-alone computer program, nor is it shown to have its own user interface (UI) for selection of a desired file, the file selection is accomplished through a sharing of the user interface with Windows NT Explorer. Therefore, the combination of Explorer and Photoimpact lacks a reasonable expectation of success.

The combination of Explorer and Photoimpact does not teach or suggest all the claim limitations.

The Examiner states on page 3 of the Final Office Action dated April 22, 2002 that "Windows NT Explorer discloses an extension...the extension sharing a user interface with the operating system...enabling display of internal file characteristics and the file image of the desired file by opening the desired file in a manner free of opening an application program in working memory...(Quick View pop-up window in Fig.2, and pop-up window in fig. 6-7, which shares an interface with windows os, enables user to open, and display the internal contents of a file, e.g., color type, graphics, font etc, and the file image without opening an application program in the computer's memory)."

Firstly, Windows NT Explorer 4.0 screen dumps Figs. 2 and 6-7 disclose a user interface for opening, and displaying the *internal file contents (image)* of a file (see Windows NT Explorer 4.0 screen dumps Fig. 3 which is the result of invoking the Quick View menu item with the desired "Dffintro" 61K Bitmap Image file selected), but not for displaying internal file characteristics or an "*indicia of internal file characteristics separate from the file image*" as claimed. The Quick View display (i.e., Fig. 3) is a display of the image itself, not including any

indicia of internal file characteristics. Nowhere does Quick View display an indicia of internal file characteristics, such as height values, width values, length values, color type value, resolution value or compression type used for storing and forming the file, and annotation graphics of the file. For example, referring to Windows NT Explorer 4.0 screen dumps Fig. 3, a person viewing the "Delrina FormFlow 1.1" image could count the pixels used to display it and determine the resolution of the image, but that process is distinguishable from "displaying the indicia of internal file characteristics separate from the file image" (e.g., a text caption reciting "Resolution: 1024x768"). Determining internal characteristics inherent in a displayed image is different, and patently distinguishable from, displaying (in a screen view) indicia of those same internal characteristics.

Additionally, certain internal file characteristics of an image are not discernable from simply viewing a displayed image. In those cases a "recitation of indicia of internal file characteristics separate from the file image" is required to elucidate those internal file characteristics. For example, the fact that an internal compression technique was used to reduce the size of the image when stored on disk is not discernable by viewing the displayed image, but would be apparent by viewing an "indicia of internal file characteristics" that displayed the compression technique.

The Examiner admits that "Windows NT Explorer fails to explicitly disclose: an extension...enabling display of indicia of internal file characteristics separate from the file image" (Final Office Action dated April 22, 2002, page 3, lines 14-16) and that "Windows NT Explorer fails to explicitly disclose: displaying the recitation of indicia of internal file characteristics separate from the file image" (Final Office Action dated April 22, 2002, page 4, lines 5-7).

The Examiner states in the Response To Arguments section of the Final Office Action dated April 22, 2002 that "...Fig. 7 Windows NT teaches the details or indication of file characteristics – compression, and type of compression used in forming the file (i.e., "zip" etc). Color type (i.e., black & white or color)...".

However, Windows NT Explorer 4.0 screen dumps Fig. 7 does not show *internal file characteristics*, and specifically does not show type of compression or color type. Windows NT Explorer 4.0 screen dumps Fig. 7 shows *external file characteristics*, such as file name/extensions, type, location, size, etc. Internal file characteristics (i.e., those obtainable by

opening and reading the file), are in contrast to external file characteristics (i.e., those obtainable by decoding a filename or reading a file allocation table). Windows NT Explorer does not open the desired file to obtain file characteristics, but relies upon the filename/file extension and/or file allocation table ("FAT") information in order to display characteristics, making those characteristics external characteristics. Although Windows NT Explorer's use of external file characteristics may provide for faster display (because it does not have to open the file), there are problems inherent in relying on filename/file extension and/or FAT information. File extensions are not a reliable source of indicia of internal file characteristics (e.g., a .ZIP file extension may falsely indicate a compressed file, because any file, compressed or not, can be given a .ZIP file extension). Additionally, there is no indication at all of color type for the bitmap image "DFFINTRO.BMP" shown in Fig. 7, in contrast to the Examiner's statements.

Therefore, the combination of Explorer and Photoimpact lacks all the limitations of independent Claims 1, 7 and 12, including: "an extension coupled to the operating system in a manner such that the extension is entirely integrated with the operating system, the extension sharing a user interface with the operating system...the extension enabling display of a recitation of indicia of internal file characteristics...by opening the desired file in a manner free of opening an application program in working memory" (Claim 1), "a file manager coupled to the operating system, including sharing a user interface with the operating system, the file manager...enabling display of indicia of internal file characteristics and file image of a user-selected file by opening the desired file...outside of an application program opened and running in the working memory" (Claim 7), and "providing operating system means for enabling display of indicia of internal file characteristics...the operating system means sharing a user interface with other operating system means and enabling display of the internal file characteristics and the file images outside of an application program opened and running in the working memory; and in a manner free of opening and running an application program in the working memory, and...displaying the indicia of internal file characteristics" (Claim 12).

Conclusion

Independent Claims 1, 7 and 12 recite the limitations of "an extension...sharing a user interface with the operating system...enabling display of a recitation of indicia of internal file

characteristics separate from the file image...by opening the desired file in a manner free of opening an application program”.

Since all the limitations of Claims 1, 7 and 12 are not taught, suggested or otherwise made obvious by the cited art (Explorer and Photoimpact) Claims 1, 7 and 12 are believed to be patently distinguishable over the cited art. Therefore, Appellants respectfully request withdrawal of the rejection of Claims 1, 7 and 12 under 35 U.S.C. 103(a).

Claims 2-6, 8-11 and 13-17 are dependent on amended base Claims 1, 7 and 12, respectively. The above remarks regarding amended Claims 1, 7 and 12 apply to dependent Claims 2-6, 8-11 and 13-17 by virtue of the fact that, if an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Where neither Explorer nor Photoimpact discloses operating system means (e.g., an extension or file manager) which, in a manner free of opening an application program, provides display of internal (not external) file characteristics, no combination of these references suggest the claimed invention. Further, where Photoimpact is an application program for displaying internal file characteristics, it runs counter and opposite from (or at least teaches away from) the Explorer Quick View features of displaying external file characteristics and sharing a user interface with the Windows operating system. Thus, Explorer and Photoimpact is not a proper combination to suggest, or make obvious, the present invention. Therefore, Appellants respectfully request withdrawal of the rejection of Claims 2-6, 8-11 and 13-17 under 35 U.S.C. 103 (a).

Claim 1 is separately patentable from Claims 7 and 12. Claim 1 is directed to a computer system file preview apparatus comprising an operating system extension and a display apparatus. Claim 7 is separately patentable from Claims 1 and 12. Claim 7 is directed to a computer system file preview apparatus comprising a file manager and a display apparatus. The file manager of Claim 7 is a specific species or embodiment of the operating system extension of Claim 1 and thus separately patentable. Claim 12 is a method in a computer system for providing file previewing. The method is a separately patentable process from the apparatus of Claims 1 and 7.

In view of the above arguments, it is respectfully requested that the rejection of Claims 1-17 be reversed such that the claims are allowed, and the application be passed to issue. This brief is being filed in triplicate.

Respectfully submitted,

HAMILTON, BROOK, SMITH & REYNOLDS, P.C.

By C. Steven Kurlowicz

C. Steven Kurlowicz

Registration No. 46,846

Telephone: (978) 341-0036

Facsimile: (978) 341-0136

Concord, MA 01742-9133

Date: 10/25/2

APPENDIX OF CLAIMS OF US PATENT APPLICATION NO.08/781,696 AS LAST
AMENDED AND FINALLY REJECTED

1. (Five Times Amended) In a computer system having (i) a working memory in which application programs are executed, and (ii) an operating system including a file manager for managing files of application programs executed in the working memory, internal file characteristics and file image preview apparatus comprising:

an extension coupled to the operating system in a manner such that the extension is entirely integrated with the operating system, the extension sharing a user interface with the operating system, the extension enabling user selection of a desired file and in response to user selection of the desired file, the extension enabling display of a recitation of indicia of internal file characteristics separate from the file image and the file image of the desired file by opening the desired file in a manner free of opening an application program in working memory and hence external to application programs in the working memory, and in a manner free of decoding the indicia of internal file characteristics from a filename of the desired file; and

a display assembly responsive to the extension for displaying the recitation of indicia of internal file characteristics separate from the file image and the file image of the user-selected desired file by opening the desired file in a manner free of opening an application program in working memory, and in a manner free of decoding the indicia of internal file characteristics from a filename of the desired file, such that a preview of the user-selected desired file is provided.
2. Apparatus as claimed in Claim 1 wherein the extension is coupled to the file manager of the operating system, such that the extension utilizes a user interface in common with the file manager to effectively provide full integration of the extension with the operating system.
3. Apparatus as claimed in Claim 1 wherein the extension in response to user selection of a desired file further enables display of a working image from the file.

4. Apparatus as claimed in Claim 3 wherein the display of the working image is a reduced-in-size version of the working image.
5. (Twice Amended) Apparatus as claimed in Claim 1 wherein the indicia of internal file characteristics include indications of at least one of height, width, length, color type, resolution, compression type used for storing and forming the file, and annotation graphics of the file.
6. (Twice Amended) Apparatus as claimed in Claim 1 wherein the file manager is a document manager for managing folders of files, and
the extension enables display of an indicia of folder characteristics of a user-desired folder.
7. (Five Times Amended) In a computer system having (i) an operating system and (ii) a working memory for executing application programs, internal file characteristics and file image previewing apparatus comprising:
a file manager coupled to the operating system, including sharing a user interface with the operating system, the file manager (a) managing files generated by application programs executed in the working memory and (b) enabling display of indicia of internal file characteristics and file image of a user-selected file by opening the desired file, said file manager being coupled to the operating system in a manner such that said display of indicia of internal file characteristics separate from the file image and the file image is generated outside of an application program opened and running in the working memory and hence external to application programs in the working memory, and in a manner free of decoding the indicia of internal file characteristics from a filename of the desired file; and
a display assembly responsive to the file manager for displaying indicia of internal file characteristics and the file image of the user-selected file by opening the desired file, outside of an application program opened and running in working memory, and in a

manner free of decoding the indicia of internal file characteristics from a filename of the desired file, said display assembly thus providing a preview of the user-selected file.

8. A system as claimed in Claim 7 wherein the file manager in response to user selection of a desired file further enables display of a working image from the file.
9. A system as claimed in Claim 8 wherein the display of the working image is a reduced-in-size version of the working image.
10. (Amended) Apparatus as claimed in Claim 7 wherein the indicia of internal file characteristics include indications of at least one of height, width, length, color type, resolution, compression type used for storing and forming the file, and annotation graphics of the file.
11. Apparatus as claimed in Claim 7 wherein the file manager includes a document manager for managing folders of files generated by application programs executed in the working memory, and enables display of indicia of folder characteristics of respective user-selected folders in a manner free of opening and running an application program in working memory, to provide respective preview of the user-selected folder.
12. (Five Times Amended) In a computer system, a method of displaying internal file characteristics and file images of a user-selected file, to provide a preview of the file, comprising the steps of:
 - providing a working memory for executing application programs;
 - executing application programs in said working memory in response to user command, said execution of the application program generating files of the computer system;
 - providing operating system means for enabling display of indicia of internal file characteristics separate from the file image and the file images of a file selected by a user by opening the file, the operating system means sharing a user interface with other

operating system means and enabling display of the internal file characteristics and the file images outside of an application program opened and running in the working memory; and

in a manner free of opening and running an application program in the working memory, and in a manner free of decoding the indicia of internal file characteristics from a filename of the desired file, displaying the indicia of internal file characteristics separate from the file image and the file images of a user-selected file, in response to user command for previewing that file.

13. (Twice Amended) A method as claimed in Claim 12 further comprising the steps of:
through the operating system means, enabling display of a working image from the user selected file; and
displaying a working image with the indicia of internal file characteristics of said file.
14. A method as claimed in Claim 13 wherein the steps of enabling display of a working image and displaying the working image include reducing size of the working image to provide a minified rendition of the working image for previewing purposes.
15. (Amended) A method as claimed in Claim 12 wherein the step of providing indications of internal file characteristics includes displaying indications of at least one of height, width, length, color type, resolution, compression type used for storing and forming the file, and annotation graphics of the file.
16. (Three Times Amended) A method as claimed in Claim 12 wherein said step of displaying indicia of internal file characteristics separate from the file image and the file images includes providing a display assembly responsive to the operating system means for displaying indicia of internal file characteristics separate from the file image and the file images outside of an application program opened and running in working memory.

17. (Twice Amended) A method as claimed in Claim 12 wherein the step of providing operating system means includes at least one of:

providing a document manager in an operating system, the document manager for managing groupings of files, the document manager enabling display of indicia of respective characteristics of user-selected groupings of the files, in a manner free of opening an application program in the working memory; and

providing a file manager in an operating system, the file manager for managing files generated from application programs executed in the working memory, the file manager enabling display of indicia of internal file characteristics of user-selected files, in a manner free of opening an application program in the working memory.